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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/752,501	01/08/2004	Shoji Ichinohe	4710-0105P	5138
2292	7590	09/20/2006		
BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747			EXAMINER PENG, KUO LIANG	
			ART UNIT	PAPER NUMBER
			1712	
DATE MAILED: 09/20/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/752,501

Applicant(s)

ICHINOHE, SHOJI

Examiner

Kuo-Liang Peng

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 7/7/06 Amendment.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 7-9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 7-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The Applicants' amendment filed on July 7, 2006 is acknowledged. Claims 1-6 are canceled. Claims 7-8 are amended. Now, Claims 7-9 are pending.
2. Claim rejection(s) under 35 USC 112 in the previous Office Action (Paper No. 040106) is/are removed.
3. The text of those sections of Title 35, U.S. code not included in this action can be found in prior Office Action(s).

Claim Rejections - 35 USC § 112

4. Claim 8 is rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for the use of a **polyethersilicone** having a specific viscosity (page 9, 2nd paragraph), does not reasonably provide enablement for the use of a **composition of matter comprising** polyethersilicone having the specific viscosity. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention commensurate in scope with this claim.

Claim Rejections - 35 USC § 102 and 103

5. Claims 7 and 9 are rejected under 35 U.S.C. 102(b) as being anticipated by Ichinohe (US 5 288 831).

Ichinohe discloses a purified polyether silicone addition reaction products of a hydrogen siloxane and a polyoxyalkylene containing a terminal double bond in the presence of a platinum catalyst, which in unpurified form contains one or both of unreacted polyoxyalkylene and internal rearrangement side reaction products thereof which generate unpleasant odors in the reaction product upon storage and upon contact with water, substantially free from said unreacted polyoxyalkylene and rearrangement products thereof so that the total quantity of ketones and aldehydes produced by a treatment of the purified polyether silicones in a closed system at 60°C. for 24 hours with a quantity of 10^{-4} N aqueous hydrochloric acid equivalent to the quantity of said polyether silicones, is no greater than 1,000 ppm of said polyether silicones, which purified polyether silicones are obtained by treating the unpurified form thereof with water, an aqueous solution of pH no greater than 7 or an acidic material, until substantially all of the odorous substances are produced and then removing the odorous substances therefrom. The polyether silicones can be an organopolysiloxane containing a

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polyoxyalkylene group represented by the formula (VI) or formula (VII).

(Abstract, col. 3, lines 18-44 and Examples) The polyoxyalkylenes are exemplified in Examples. Ichinohe further teaches a solvent formulation for hair care, etc., comprising the polyether silicone. Note that “for an electrolytic solution” is merely an intended use, and does not carry any weight of patentability. See MPEP 2111.02. Ichinohe further teaches that the polyether silicone is subjected to vacuum distillation. (col. 6, lines 3-14)

6. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ichinohe.

Ichinohe discloses a purified polyether silicone addition reaction products, *supra*, which is incorporated herein by reference.

Ichinohe is silent on the polyether silicone having the specific viscosity set forth in the instant claim. However, Ichinohe teaches the use of the polyether silicone in the formulations for hair care, etc. (col. 4, lines 24-49) Note that the viscosity of the polyether silicone will affect the viscosity of the formulation. Therefore, the viscosity of the polyether silicone is a Result-Effective variable. In light of which, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to utilize a polyether silicone having whatever

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viscosity through routine experimentation in order to afford a formulation with a desired viscosity.

Responsive to arguments regarding 35 USC § 102 and 103 rejection

7. Applicant's arguments have been fully considered but they are not persuasive. The focus argument related to the core patentability is discussed below.

For Applicants' argument (Remarks, page 4, last paragraph), it appears that Ichinohe's vacuum distillation is performed on the **post-reaction solution** as described in col. 6, lines 3-7.

For Applicants' argument (Remarks, page 5, 1st paragraph), Ichinohe's process reads on the claimed invention. As such, the unreacted polyether, propionaldehyde, etc. should be removed.

For Applicants' argument (Remarks, page 5, 2nd and 3rd paragraphs), the claimed invention does not exclude the possibility of treating the post-reaction solution with an aqueous solution having a specific pH value.

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL.**

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See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kuo-Liang Peng whose telephone number is (571) 272-1091. The examiner can normally be reached on Monday-Friday from 8:30 AM to 5:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski, can be reached on (571) 272-1302. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306. Information regarding the status of an

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application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

klp

September 14, 2006



Kuo-Liang Peng
Primary Examiner
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